

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>KOLS.054PA</b>									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number <b>10/695,521</b>	Filed <b>October 28, 2003</b>									
	First Named Inventor <b>Mahonen</b>										
	Art Unit <b>2617</b>	Examiner <b>Lim, S.</b>									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px; text-align: right;">/Erin Nichols Matkaiti/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px; text-align: right;"><b>Erin Nichols Matkaiti</b> _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>57,125</b></td><td style="vertical-align: top; padding: 5px; text-align: right;"><b>952-232-6907</b> _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px; text-align: right;"><b>July 6, 2011</b> _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/Erin Nichols Matkaiti/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<b>Erin Nichols Matkaiti</b> _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>57,125</b>	<b>952-232-6907</b> _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<b>July 6, 2011</b> _____ Date
<input type="checkbox"/> applicant/inventor.	/Erin Nichols Matkaiti/ _____ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<b>Erin Nichols Matkaiti</b> _____ Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>57,125</b>	<b>952-232-6907</b> _____ Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<b>July 6, 2011</b> _____ Date										
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant:	Mahonen et al.	Examiner:	Lim, S.
Serial No.:	10/695,521	Group Art Unit:	2617
Filed:	October 28, 2003	Docket No.:	KOLS.054PA
Confirmation No.:	5404	Customer No.:	10888
Title:	DATA SYNCHRONIZATION		

---

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this paper is being electronically transmitted by EFS-WEB to the United States Patent and Trademark Office on July 6, 2011.

By: /Erin Nichols Matkaiti/  
Erin Nichols Matkaiti

**APPELLANT'S STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF  
REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005, on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

The § 103(a) rejections are primarily based on two combinations of references:

- 1) U.S. Publication No. 2001/0041592 by Suonpera *et al.* (hereinafter "Suonpera") as modified by the teachings of U.S. Publication No. 2003/0069874 by Hertzog *et al.* (hereinafter "Hertzog"); and
- 2) U.S. Publication No. 2003/0023759 by Littleton *et al.* (hereinafter "Littleton") as modified by the teachings of Suonpera and U.S. Patent No. 6,247,135 to Feague (hereinafter "Feague").

Independent claims 12, 17, 18, 32, and 39 are rejected solely in view of the first combination, and independent claims 1, 9, 16, and 23 are rejected solely in view of the second combination.

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for a *prima facie* obviousness rejection. Appellant maintains that the first combination of teachings fails to teach or suggest each of the claimed elements, and the requisite motivation has not been provided for a skilled artisan to perform the second combination. To establish a *prima facie* § 103(a) rejection of at least the independent claims, these claimed elements must be present in Suonpera and Hertzog, as the Examiner alleges in the Office action dated January 6, 2011 (hereinafter “final Office action”), and the Examiner must provide the requisite motivation having a rational underpinning.

Independent claims 12, 17, 18, 32, and 39

**1. Neither Suonpera nor Hertzog has been shown to teach a mobile communications device performing the claimed first and second synchronization steps.**

Each of independent claims 12, 17, 18, 32, and 39 are directed to mobile communications devices. However, the cited portions of Suonpera (*e.g.*, paragraphs [0061] and [0062]) describe features of an application on a PC (*see, also* paragraph [0060]). The assertion at page seventeen that “Littleton discloses synchronization using a PDA which is a mobile communications device” is inapplicable since none of these independent claims is rejected in view of Littleton. Without correspondence to each of the claimed elements, the rejection of at least these claims is in error.

**2. Neither Suonpera nor Hertzog teaches or suggests the claimed checking of availability of user data units, requesting unavailable user data units, and forming binding on the further received user data units, each of which is based on received binding data.**

The Examiner acknowledges that Suonpera at least does not teach or suggest a mobile communications device checking if all user data units defined in the received binding data are available in the mobile device, requesting a user data unit that is defined in the received binding data but not available in the mobile device from the second communications device, and forming binding with the further received user data unit (page 9, line 15 through page 10, line 2, final

Office action), as claimed. In an effort to overcome this, the Examiner relies on Hertzog. However, this reliance is misplaced as Hertzog also fails to teach or suggest such elements.

Hertzog does not teach or suggest the claimed checking if all data units defined in received binding data are available (emphasis added). Since Hertzog fails to suggest binding data associating a user data identifier identifying a user data unit with an identifier for identifying at least one function of a communications device, Hertzog fails to suggest any of the claimed actions regarding such binding data (received in a second synchronization step). Although the Examiner contends that Suonpera teaches the existence of binding data (again at page 18), the Examiner acknowledges that Suonpera does not perform the claimed elements utilizing such binding data. Instead, Hertzog merely discloses in paragraph [0058] a general synchronization between external entities and a client application 18 (of a client machine 12, *see* Fig 1). The cited “obtain updates” merely refers to the synchronization engine obtaining data changed since the last synchronization event. The asserted “checking for matching data” between two devices (page 18) fails to correspond to checking availability within a device based on received binding data identifying the user data units being checked. There is no teaching or suggestion that Hertzog’s “updates” involve receiving binding data and checking if all user data units defined in such binding data are available in a mobile communications device, as claimed.

Hertzog also fails to disclose the claimed request of at least one further user data unit from the second communications device in response to the at least one user data unit defined in the received binding data not being available in the mobile communications device on the basis of the check. The cited “reconcile conflicts” in paragraph [0058] is instead part of data synchronization by the synchronization engine 28, i.e. when the data sets of the databases of different devices being synchronized are compared. To illustrate, there may be a conflict if the same data item has been stored in two databases at different times, and the engine 28 may thus select a newer one to be maintained. There is no teaching or suggestion that a user data unit is requested from another device based on received binding data and a check of availability within the receiving mobile device.

In addition, Hertzog fails to teach or suggest the claimed forming of a binding between the received at least one further user data unit and at least one of functions of the mobile communications device in accordance with the binding data. The cited “mapping operation” in paragraph [0059] is instead directed to mapping between fields of databases, not binding to

device function-related features, as claimed. Thus, Hertzog fails to overcome several of the elements acknowledged to be missing from Suonpera. Without a presentation of correspondence to each of the claimed elements, the § 103(a) rejection is in error. Appellant accordingly requests that the rejection be withdrawn.

#### Independent claims 1, 9, 16, and 23

Appellant maintains that no reasoning with a rational underpinning has been presented to modify the teachings of Littleton, as proposed by the Examiner. In an effort to overcome the fact that Littleton does not teach or suggest a second synchronization step, as claimed, the Examiner asserts that Suonpera would teach such a step. However, the Examiner has not demonstrated why it would have been obvious to have the two separate synchronization steps, or why Littleton would be modified to have two separate synchronization steps.

In section six of the final Office action the Examiner generally asserts that it would have been obvious to transfer binding data in a second synchronization step “in order to synchronize all settings of a first phone to a second device to backup all settings for data recovery purposes . . . .” However, this (as well as the assertion “which enables the user to easily change phones” in section four) fails to demonstrate obviousness of the binding data being synchronized as a separate, second step as claimed since it could be transferred in a single step as already taught by Littleton. Instead of teaching, or even enabling separation of data to separate synchronization events, Littleton emphasizes that the telephone service feature information and the phone numbers are transmitted in a single step, and that such information is compressed into a compressed coded string. No evidence of motivation to deviate from this approach, or in particular separating the synchronization of the contact information and the contact, has been provided.

Moreover, adding a second synchronization step to Littleton would not result in synchronizing binding data separately since Littleton already teaches synchronizing the asserted binding data in the first step. Since Littleton already teaches a synchronization step, Littleton already teaches synchronizing all settings of a device (PDA) to a second device (PC) to backup all settings for data recovery purposes and enables a user to change devices. Therefore, no evidence has been presented to modify Littleton to synchronize data in separate synchronization steps as claimed. Without the requisite evidence of motivation to modify Littleton as asserted,

the § 103(a) rejection of at least these independent claims is in error. Appellant accordingly requests that the rejection be withdrawn.

It is respectfully submitted that there are omissions of essential elements required for a *prima facie* presentation of obviousness for the rejections of at least the independent claims. The Examiner's reliance on at least Hertzog is in error, as Hertzog fails to teach or suggest each of the elements admittedly absent from Suonpera. Also, the requisite rationale for modifying Littleton, as asserted, has not been presented.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections of the independent claims are in error and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

**HOLLINGSWORTH & FUNK, LLC**  
Attorneys at Law  
8500 Normandale Blvd., Suite 320  
Minneapolis, MN 55437  
952.232.6907(tel.)

By: /Erin Nichols Matkaiti/  
Name: Erin Nichols Matkaiti  
Reg. No.: 57,125